

REMARKS

Claims 15-16 and 20-29 are pending.

Claims 15-16 and 20-29 stand rejected.

Claims 15-16 and 20-29 are hereby submitted for review and consideration.

No new matter has been added.

In the Office Action, the Examiner has rejected claims 15-16 and 20-29 under the first paragraph of 35 U.S.C. § 112 as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner, contends that the Applicant's arguments filed September 15, 2003 have been fully considered but are not persuasive. He states,

“Figures 9A and 9B only show interrupted lines to indicate a straw is located inside the container. They do not show the specific orientation of the lower portion of the straw as claimed. There is on [sic] further description in the specification to further detail the specific orientation as claimed. Applicant only speculates what that dotter[sic] lines in the drawing may do. Any claimed specific arrangement of the straw inside the container is considered as new matter.”

Applicant respectfully disagrees with the Examiner's contentions and submits the following remarks in response.

Applicant notes that this rejection was originally, raised in the November 14, 2002 Advisory Action and again in the Office Action dated March 10, 2003. In the Amendment of September 10, 2003, Applicants responded, but the Examiner stated that the arguments were unpersuasive.

Application No. 09/669,245
Amendment dated April 30, 2004
Reply to Office Action of December 2, 2003

The gravamen of the issue raised by the Examiner is that certain elements of the claims are not supported or enabled by the specification as filed. In particular the Examiner contends that certain elements of the independent claims, namely claims 15, 22 and 26 are not supported in the specification as filed.

In claim 15, the Examiner contends that the un-supported element is:

“where said lower portion extends downwardly against said first side wall”

In claim 22, the Examiner contends that the un-supported element is:

“said upper portion, coupled with an inner side of said cap, and said lower portion are connected by pleats, wherein the configuration between the upper and lower portions of the straw are such that the pleats are required to allow an unimpeded flow of liquid that passes through said straw”

It is assumed that the upper portion being attached to the cap and the pleated connection are not in dispute as these portions are specifically mentioned in the specification on page 10, lines 21-23 state that the carton has a “scored finger portion 60 that can be pulled open to expose straw 62 that is attached to the underside of finger 60. Straw 62 has pleats 64 that allow it to bend without impeding the flow of liquid.” As such, the Examiner’s dispute must be with the element of claim 22, which recites the configuration between the upper and lower portions of the straw are such that the pleats are required to allow an unimpeded flow of liquid that passes through the straw.

In claim 26, the Examiner contends that the un-supported element is:

“said lower portion is disposed along said first side wall, parallel to both the edges of and the plane of said first side wall”

Applicant asserts that each of these conclusions is plainly in error for the following reasons.

Application No. 09/669,245
Amendment dated April 30, 2004
Reply to Office Action of December 2, 2003

Regarding Claim 22

In this claim the element presented is:

“said upper portion, *coupled with an inner side of said cap*, and said lower portion *are connected by pleats*, wherein the configuration between the upper and lower portions of the straw are such *that the pleats are required to allow an unimpeded flow of liquid that passes through said straw*”

The Examiner has rejected this element as not being properly supported by the specification.

Applicant notes that in order to make such a rejection, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See MPEP § 2164.04, citing *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure).

Furthermore, it is incumbent upon the Examiner, whenever a rejection on this basis is made, to explain why the Examiner doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise there would be no need for the Applicant to go to the trouble and expense of supporting his presumptively accurate disclosure. See MPEP § 6164.04 citing to *In re Marzocchi* 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971).

In the present application, Applicant notes above that coupling of the upper portion to the cap and the connecting of the upper and lower portions with pleats is taken

Application No. 09/669,245
Amendment dated April 30, 2004
Reply to Office Action of December 2, 2003

directly from the specification as filed.

In fact, the element “*that the pleats are required to allow an unimpeded flow of liquid that passes through said straw*” is a near direct recitation of the specification, page 10, lines 21-23 which states “*Straw 62 has pleats 64 that allow it to bend without impeding the flow of liquid.*”

In the Office Action, the Examiner, rather than issuing any supporting statements as to how he drew his conclusions that the specification does not support this element of claim 22, instead conclusively states, that Figs. 9A and 9B do not show the orientation within the container as claimed and that “there is on[sic] further description in the specification what that dotter[sic] lines in the drawings may do.” The first portion of the statement is not applicable to the claim 22 analysis and the second portion of the statement is false as demonstrated above.

Figs. 9A and 9B are not used as the principle support for enabling the elements of claim 22, they merely add to the already completely adequate description on page 10 of the specification. Furthermore, the statement that the specification contains no further description on this point is false, as it clearly does state, “*Straw 62 has pleats 64 that allow it to bend without impeding the flow of liquid.*”

As such, Applicant can not determine on what basis the Examiner is rejecting claim 22, or the claims that depend therefrom, under the auspices of the first paragraph 35 U.S.C. § 112, as all of the elements of this claim are clearly recited in the text of the specification on page 10. In addition, although this element is shown in Figs. 9A and 9B, it is not necessary for the Applicant to rely solely on these figures alone for supporting this element of claim 22, when the text alone is support for the element as well.

Application No. 09/669,245
Amendment dated April 30, 2004
Reply to Office Action of December 2, 2003

Therefore, Applicant respectfully submits that the Examiner has failed to make a *prima facia* case for lack of enablement under paragraph 1 of 35 U.S.C. § 112 nor has he rebutted the Applicant's previous arguments on this point which have already been set forth on page 6 of the January 29, 2003 Amendment. Therefore, Applicants respectfully request that the Examiner's rejection of claim 22, and the claims that depend therefrom, under 35 U.S.C. § 112 be withdrawn.

Regarding Claims 15 and 26

In these claims the elements presented are:

“where said lower portion extends downwardly against said first side wall” (claim 15)

and

“said lower portion is disposed along said first side wall, parallel to both the edges of and the plane of said first side wall” (claim 26)

The Examiner has rejected these elements as not being properly supported by the specification.

In this instance, as previously stated in the Amendment of September 10, 2003, the text of the specification partially supports these elements, and they are completely supported when viewing the specification and figures together.

It is noted that in the previous two Amendments, Applicant indicated that the figures alone can be sufficient to support the elements of claim. Applicant cited to the Court of Appeals for the Federal Circuit which has recognized that, “drawings alone may

Application No. 09/669,245
Amendment dated April 30, 2004
Reply to Office Action of December 2, 2003

provide a ‘written description’ of an invention as required by §112.” *See Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1565, 19 USPQ 2d 1111, 1117 (Fed. Cir. 1991); *See also In re Heinle*, 145 USPQ 131 (CCPA 1965) (Where the court stated that it is proper to include matter that is clearly and conclusively disclosed by the drawings. Were the drawings appear to conform to the one-fourth circumference limitation, it is possible to amend the application to include the one-fourth limitation without violating the rule against “new matter”.)

As such, Applicant assumes that the Examiner, does not contest this point, but instead is relying on his contention that even if figures can support the elements of the claims in general, Figs. 9A and 9B of this specification do not support the elements of claims 15 and 26.

In view of this assertion by the Examiner it is noted that in such a situation, Applicant may submit factual affidavits under 37 CFR 1.132 to show what one skilled in the art would understand by reading the disclosure. A declaration or affidavit is, itself, evidence that must be considered. See MPEP § 2164.05 and *In re Alton* 76 F.3d 1168, 1174, 37 USPQ2d 1578, 1583 (Fed. Cir 1996). In its response of September 10, 2003, Applicants submitted three separate declarations attesting to the fact that Figs. 9A and 9B do indeed support the elements rejected by the Examiner. Copies of the three declarations submitted in the previous amendment are attached in the Appendix for the Examiner’s review.

Applicant is aware that the statements made in such declarations must be more than conclusory. However, each of the declarants made specific reasoned statements, not only that Figs. 9A and 9B supported the language of claims 15 and 26, *but also gave*

Application No. 09/669,245
Amendment dated April 30, 2004
Reply to Office Action of December 2, 2003

specific reasons why they reached their conclusion as well, as discussed below. See *In re Buchner* 929 F.2d 660, 661 18 USPQ2d 1331, 1331 (Fed. Cir 1991).

Furthermore, in *Vas-Cath, Inc.*, the CAFC judges specifically relied on the evidence presented in a Declaration confirming that the drawings did in fact convey to one of ordinary skill in the art the necessary support for the claimed language. In further support of its decision, the Court cited to the lack of any contrary evidence, to indicate how one of ordinary skill in the art could interpret the drawings to the contrary of that presented in the Declaration. See *Vas-Cath* at 1566-1567.

In view of this rule, Applicant, in the September 10, 2003 Amendment, submitted three independent Declarations pursuant to 37 CFR 1.132 in support of the contention that Figures 9A and 9B did in fact show the lower portion of the straw extending downwardly against said first side wall and also that they showed the lower portion disposed along said first side wall, parallel to both the edges of and the plane of said first side wall.

In the present case, the first declaration presented was from a mechanical engineering professor, Sidi Berri. The second declaration was from a mechanical and solar engineer and owner of a plastics corporation (which among other things produces plastic straws), Jacob Cohen. And the third declaration was from an architectural designer, Daniel Kamel.

In each of the three declarations, it is positively asserted that Figs. 9A and 9B of the application clearly show that the straw is attached to the inner first side wall of the container. Their assertions rested on their knowledge and experience with technical drawings. They specifically indicated the reasons for their decisions, noting that their

Application No. 09/669,245
Amendment dated April 30, 2004
Reply to Office Action of December 2, 2003

conclusions were reached because the dotted lines, depicting the straw, extends in parallel with both sides of the surface of the wall the straw extends along, and do not exhibit any ambiguity. Such assertions are not simple conclusory statements, but instead rest on an examination of the figures at hand.

Further to this, they go on to state that their conclusions, about Figs. 9A and 9B, are even more apparent from Figs. 8A and 8B, where the straw is depicted as a straw, floating within the container using the same dashed lines. They note that in contrast with Figs 9A and 9B, the dotted lines representing the straw are not parallel with any of the sides of the surface of the walls of the container. Thus, they conclude that Figs. 8A and 8B show that the straw is floating, whereas Figs. 9A and 9B show that the straw is attached.

In response, to these declarations, and to the Applicant's own comments along the same line (as the Applicant is also familiar with such aspects of the drawings) in the previous two Amendments, the Examiner merely ignores the comments, and makes the conclusory statement that, Figures 9A and 9B only show interrupted lines to indicate a straw is located inside the container and that they do not show the specific orientation of the lower portion of the straw as claimed.

As such, the Examiner has failed to directly rebut the assertions provided by the declarants. Just as in *Vas-Cath*, and in violation of the requirements stated in MPEP § 2164 and *In re Alton*, the Examiner in the present case has not provided any evidence contrary to the evidence provided by the Applicant in the form of the three declarations.

Therefore, Applicant asserts that such a brief statement on the part of the Examiner fails to make a *prima facia* case that claims 15 and 26 are not supported in the

Application No. 09/669,245
Amendment dated April 30, 2004
Reply to Office Action of December 2, 2003

specification. As noted above both *In re Wright* and *In re Marzocchi*, the Examiner is required to make more than conclusory statements. The Examiner is required to provide support for its conclusions.

It is noted that Applicant has addressed all of the Examiner's previous substantive rejections based on prior art in the previous Amendment of September 10, 2003, and the Examiner has not repeated those rejections herein in the present Final Office Action. As such, no further treatment is provided.

In view of the forgoing Applicant respectfully submits that the present invention as claimed in claims 15-16 and 21-29 is now in condition for allowance, the earliest possible notice of which is earnestly solicited. If the Examiner feels that a telephone interview would advance the prosecution of this application he is invited to contact the undersigned at the number listed below.

Respectfully submitted

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